

Response under 37 C.F.R. §1.111  
Attorney Docket No. 010320  
Serial No. 09/803,011

**REMARKS**

Claims 1-5 are pending in this application. Claims 1-4 stand rejected and claim 5 is withdrawn from consideration.

**Applicant's Response to the Rejection under 35 U.S.C. §103**

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 64-81874 in view of *Reisser et al.* (U.S. Patent No. 5,332,767) as set forth in the Office Action mailed April 14, 2004. The Examiner sets forth that: there is sufficient motivation to combine in the prior art; applicant's intended use does not impart patentability; and, the combination would not destroy the intended function of such reference. Applicant respectfully traverses as follows.

In regard to the motivation to combine, the Examiner asserts that the general consumer desire to have different colored inks is sufficient motivation. Applicant respectfully submits that this argument does not take into account the technical requirements to form a functioning ink. The Examiner is assuming that one skilled in the art would readily know that a metal pigment of *Reisser et al.* will bond properly with both the surface treatment and binder of JP '874. In essence, the Examiner is stating that the use of any particle will work in place of carbon black. This goes against the teachings of JP '874 which in the abstract states:

“... the carbon black has a high affinity for the component of ink binder **through the polymer**, and consequently, the use of this ink can give ... images with high quality and excellent durability.”  
(emphasis added)

Hence, applicant submits that it would not be obvious to substitute a metal particle for carbon black and reasonably expect success. A metal particle will not have the same affinity for the component of ink binder **through the polymer** as carbon black.

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The Office Action states that the intended use does not impart patentability. However, applicant respectfully submits that the intended use does demonstrate that the current invention would not be obvious in light of the cited prior art. As set forth in Patent No. 2997636 (corresponding to USP5648414) referred to at page 2 of the specification, the invention of this application relates to a printing ink suitable for integration of a decorated film or sheet printed by a printing ink during injection molding of synthetic resin, and the pictured sheet of the invention is made integral during the injecting molding of the resin.

Contrary, JP'874 relates to an ink sheet for thermal transfer printing that is a non-impact printer style, which is used to transfer a part of its ink onto already transferred synthetic resin molding. Hence, the ink sheet of JP'874 is different from that of the invention of this application in terms of application fields, and so it is evident that the properties demanded differ. Thus, regardless of the commercial desire for different colored inks, the invention of this application would have not been obvious to those skilled in the art. A skilled artisan is aware of this distinction in the art and thus would not have a reasonable expectation of success in making the combination.

The Examiner also maintains that the function of the referenced inventions would not be destroyed by the combination. Specifically the Office Action states:

“There would be no destruction of the intended function of JP ‘874 by substituting the metal particle of *Reisser et al.* for the non-metal particle of JP ‘874 since the metal particle of JP ‘874 (modified) would have an outer coating to polyamine or modified polyamine.”

-page 3, section 4 of the current Office Action

Applicant respectfully submits that this argument does not address the teachings of JP'874. As noted above, JP ‘874 specifically utilizes carbon black because of its high affinity through the polymer. Hence, by substituting carbon black with a metal particle there would be a

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lack of "high quality and excellent durability" which are the advantages and intended function of JP '874.

In view of the aforementioned remarks, Applicants submit that that the claims, as previously presented, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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